

BP0206US-CN1

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III. REMARKS

1. Remarks on the Amendment to the Claims:

By preliminary amendment dated September 5, 2006, claims 11-27, 29-40, 42-51, 53-62 and 64-74 were canceled. The present restriction requirement appears to omit any reference to the entry of said preliminary amendment.

By the amendment set forth above, claims 1-27, 29-40 and 41-74 have been canceled. The newly added claims are identical to original claims 29-40 and 42-51, respectively. Thus, by this amendment, the claim set is identical to Group II, claims 28-51 as outlined in the restriction requirement. The presently pending claims, however, are numbered 28, 41 and 75-91. No new matter has been added.

The present application names as inventors: Ralph A. Casale, Subhakar Dey, James M. Coull, Kevin Z. Gan and Bruce A. Kowalczyk. It is believed that this is the proper inventive entity for this set of claims.

2. Response to the Restriction Requirement:

a) Elections

In response to the restriction requirement, Applicants hereby elect Group II, claims 28-51 (now claims 28, 41 and 75-91) drawn to a method for chemically synthesizing a PNA dimer.

According to the restriction requirement:

"Applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims will be restricted if no generic claim is finally held to be allowable."

(OA at page 3)

and

"Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added."

(OA at page 4)

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Because Applicants must select a single species in order for the response to the restriction requirement to be complete (37 C.F.R. § 1.146), Applicants select the following species for subparts A-D according to Page 3 of the restriction requirement.

Part A: solid support = "trityl chloride resin"

Part B: loading range of PNA dimers = "greater than or equal to 0.08 mmol per gram"

Part C: deprotection reagent/solvent = "about 0.2% to about 4% (v/v) DBU in NMP"

Part D: PNA oligomer subunit length/length range = "about 3 to about 8 subunits in length"

The following Table summarizes the pending claims that are believed read on said species election(s).

Part	Election	Relevant Claims
A	trityl chloride resin	28, 41, 82, 83, & 93
B	greater than or equal to 0.08 mmol per gram	28, 41, 84, 85, 86, 95 & 96
C	about 0.2% to about 4% (v/v) DBU in NMP	28, 41, 80 and 81
D	about 3 to about 8 subunits in length	None Pending

However, Applicants traverse this species election for the following reasons.

Consequently, compliance with the species election should not be considered as Applicants' implicit consent to the Office's action.

b) Basis for Traverse

Regarding the species election, Applicants challenge any attempt by the Office to restrict any subject matter within a specific claim or claims. Applicants further traverse any requirement that is inconsistent with the decisions of: *In re Weber*, 580 F.2d 455, 198 U.S.P.Q. 328 (CCPA, 1978), *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), *In re Harnisch* 631 F.2d 716, 206 USPQ 300 (CCPA) and/or *Ex Parte Hozumi*, 3 USPQ2d 1059 (BPAI 1984).

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IV. SUMMARY

It is believed that this response addresses all issues set forth in the present Restriction Requirement and the application is in ready condition for allowance. In consideration of the preceding amendments and remarks, Applicants hereby respectfully request reconsideration of all pending claims, the withdrawal of all rejections set forth in the present Action and issue of a Notice of Allowance by The Office.

V. INTERVIEW

If the Examiner believes a telephonic or personal interview would advance the prosecution of the subject application, the Examiner is invited to contact attorney Gildea during business hours at the telephone or facsimile numbers listed below.

VI. FEES

A request for an automatic one-month extension of time to reply to the restriction requirement dated June 9, 2006 and authorization to charge the appropriate fee to Deposit account No. 01-2213 accompanies this paper. A new fee calculation sheet and authorization to pay appropriate fees for consideration of all claims presently pending also accompanies this submission. No other fees are believed to be due to The Office for consideration of this paper. If however, The Office determines that any fee is properly due for its consideration of this paper, authorization is hereby granted to charge any required fee associated with the filing or proper consideration of this paper to Deposit Account 01-2213 (Invoice No. BP0206US-CN1).

VII. CORRESPONDENCE/CUSTOMER NUMBER

Please send all correspondence pertaining to this document to:

Brian D. Gildea, Esq.
Applied Biosystems
500 Old Connecticut Path
Framingham, MA 01701
Telephone: 508-383-7632
Fax: 508-383-7468
Email: brian.gildea@appliedbiosystems.com

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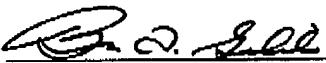
IF NOT ALREADY DONE, PLEASE ASSOCIATE THIS CASE WITH CUSTOMER
NUMBER

23544

Respectfully submitted
on behalf of Applicants,

July 31, 2006

Date



Brian D. Gildea, Esq.; Reg. No. 39,995